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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,834	04/18/2001	John A. Corey	107044-0007	9684

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EXAMINER

CHANEY, CAROL DIANE

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 02/03/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/837,834

Applicant(s)

COREY ET AL.

Examiner

Carol Chaney

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2001 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7,10-12,15,16,19,20 and 23 is/are rejected.
- 7) ☒ Claim(s) 3,4,8,9,13,14,17,18,21 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . 6) ☐ Other: _____ .

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 6, 7, 11, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Bahar et al., US Patent RE 37656 E.

Bahar et al. disclose a composite layered structure comprising an expanded polytetrafluoroethylene (PTFE) membrane impregnated with an ion exchange material throughout the membrane. The ion exchange material substantially impregnates the membrane so as to render an interior volume of the membrane substantially occlusive, and thus impermeable to water and carbonaceous fuel. (column 2, lines 43-64.) In a preferred embodiment, NAFION is brushed onto both sides of a microporous PTFE membrane, thus providing an impervious layer of PTFE

and NAFION, with protonically conductive membranes on both sides of the impervious layer. (Column 11, lines 38-53.) The micropores in the PTFE which are filled with ionically conducting NAFION are sites which allow protonically conductive contact between the outer NAFION layers.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5, 10, 15, 16, 19, 20, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar et al.

As discussed above, Bahar et al. disclose applicants' invention essentially as claimed, with the exception that Bahar et al. do not specifically disclose a direct oxidation fuel cell, or the catalytic and diffusion layers for such a fuel cell. Bahar et al. teach that the ion exchange materials of their inventive membrane may be include powders such as carbon black, graphite, nickel, silica, titanium dioxide, or platinum black, to provide catalytic effects. (Column 5, lines 2-11.) Therefore, catalyst layers as recited in applicants claims 1, 2, 5, 10, 15, 16, 19, 20, and 23 are disclosed by Bahar et al. Bahar et al. teach the membrane of the present invention may be used for a fuel cells and the use of the membrane results in fuel cells with improved ionic conductance and water transport across the membrane, and require less fuel gas humidification.

(Column 10, lines 58-65.) This teaching of the Bahar et al. invention generically in polymer-electrolyte fuel cells is considered to encompass teaching the use of the membrane in direct methanol fuel cells. Thus, applicants' invention as a whole would have been obvious to one of ordinary skill in the art based upon the teachings of Bahar et al.

Allowable Subject Matter

Claims 3, 4, 8, 9, 13, 14, 17, 18, 21 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to suggest membrane assemblies as claimed having a polyester or polyimide layer which is substantially impervious to water and carbonaceous fuel.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rusch et al., US Patent 6,130,175 discloses multi-layer MEA's

Banerjee, US Patent 5,795,668 discloses direct methanol fuel cells.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol Chaney whose telephone number is (703) 305-3777. The examiner can normally be reached on Mon - Fri 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 703-308-2383. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Carol Chaney
Primary Examiner
Art Unit 1745

cc
January 25, 2003